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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,217	04/26/2006	Peter Alfred Newman	0244	3420
31665 7590 02/07/2011 PATENT DEPARTMENT ROVI CORPORATION 2830 DE LA CRUZ BOULEVARD SANTA CLARA, CA 95050				
EXAMINER				
WILLIAMS, JEFFERY L.				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/577,217

**Applicant(s)**

NEWMAN ET AL.

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 19, and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 19, 21, 22, 25, 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draft Person's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to the communication filed on 9/21/10.

Claims 1 – 11, 19, and 21 – 26 are pending.

Claims 9,10,23,24 are withdrawn from consideration.

### ***Election/Restrictions***

This application contains claims 9, 10, 23, and 24 drawn to an invention nonelected without traverse in the reply filed on 4/19/10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 – 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schylander, U.S. Patent 5,390,159.**

Regarding claim 1, Schylander discloses:

*An optical disc comprising content (e.g. Schylander, 1:14-22) arranged on the disc in at least two separate and consecutive sessions (e.g. Schylander, 15:46-53), wherein each session has a Lead-In and a Lead-Out, both containing Q-data (e.g. Schylander, fig. 4; 15:46-53 – herein the prior art disclose the recorded Lead-In and Lead-Out information areas of a compact disc, i.e. "Q-data") and wherein: information in the Q-data of at least one session's Lead-In for identifying a format of the session is preset irrespective of the format of the at least one session (e.g. Schylander, fig. 4:"LI1"); and none of the sessions has a pointer in the Q-data of that session's Lead-Out which references a primary volume descriptor of that same session (e.g. Schylander, fig. 4: "LO1", "LO2", "LSN=SZ", "LSN=offs", "LSN=offs+16", "LSN=offs+SZ"; 6: 67 – 7:21, 53 – 66; see also fig. 5, 7, 14; 8:7-34; 10:13-11:9; 13:12-40 – herein the prior art establishes a way to record and successfully navigate all information on a disc with the use of references or offsets that point to the location of all volume descriptors, wherein such references to volume descriptors are not found within the Lead-out areas).*

Regarding claim 2, Schylander discloses:

*wherein none of the sessions on the disc has a pointer from the Lead-Out thereof which references or addresses a primary volume descriptor of that same session (e.g. Schylander, fig. 4: "LO1", "LO2").*

Regarding claim 3, Schylander discloses:

*wherein there are between two and five sessions on the disc* (e.g. Schylander, fig. 4; 15:46-53).

Regarding claim 4, Schylander discloses:

*wherein the content is arranged on the disc in first and second separate sessions* (e.g. Schylander, fig. 4; 15:46-53).

Regarding claim 5, Schylander discloses:

*wherein each session further has a program area, and wherein none of the sessions on the disc has a pointer in the Q-data of that session's Lead-Out which references the program area of that session* (e.g. Schylander, fig. 4: "LO1", "LO2"; 15:46-53).

Regarding claim 6, Schylander discloses:

*wherein the first consecutive session is an audio session having audio data contained in the program area of that session* (e.g. Schylander, fig. 1; 4:42-48 - \* recorded bits within a user's program area may be intended for interpretation as data of the type audio, visual, etc. However, it is noted that the classification of recorded bits or digital information by it's intended interpretation (i.e. audio, video, etc) does not serve to structurally distinguish the claimed optical disc having digital information recorded thereon from prior art optical discs having digital information recorded thereon).

Regarding claim 7, Schylander discloses:

*wherein a session following the first session is a data session, wherein the data session has a primary volume descriptor in its program area, and wherein there is no pointer in the Q-data of the data session's Lead-Out which references the primary volume descriptor (e.g. Schylander, fig. 4: "LO1", "LO2"; 4:43-58).*

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8, 11, 19, 21, 22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schylander in view of Hahn, U.S. Patent Publication 2004/0109393.**

Regarding claim 8, Schylander discloses an optical disc (e.g. Schylander, 1:14-56), however, Schylander does not disclose copy protection of the optical disc. Hahn discloses the need to copy protect optical discs (Hahn, par. 2-10).

It would have been obvious to one of ordinary skill in the art to employ the teachings of Hahn with the teachings of Schylander. This would have been obvious

because one of ordinary skill in the art would have been motivated by the need to prevent unauthorized or illegal copying (Hahn, par. 9, 10).

The combination enables:

*having a first audio session and at least one subsequent data session, the optical disc being a copy protected audio disc (e.g. Schylander, fig. 4; Hahn, par. 11; fig. 1a).*

Regarding claim 11, comprises essentially similar recitations as claims 1 – 8, and it is rejected, at least, for the same reasons as claim 8, and furthermore because the combination enables:

*and wherein the primary volume descriptor in the at least one subsequent session which relates to the audio session has been removed, corrupted, or rendered incorrect (Hahn, par. 22).*

Regarding claim 19, the combination enables:

*wherein the content is arranged on the optical disc in two sessions only, a first session being the audio session, and the second session being a data session, and wherein the second session has a primary volume descriptor enabling access to data in a program area of the second session, and where there is no pointer referencing the primary volume descriptor from the Lead-Out of the second session (e.g. Schylander, fig. 4; Hahn, fig. 6).*

Regarding claims 21, 22, and 25 – 27, they are method claims corresponding to the claims 1 – 8, and 11 and 19 above, comprising essentially similar recitations, and they are rejected, at least, for the same reasons.

### ***Response to Arguments***

Applicant's arguments filed 9/21/10 have been fully considered but they are not persuasive.

*Applicant argues or asserts essentially that:*

The Office Action (page 4) cites Schylander Figure 4 "LO1", "LO2". However, this figure fails to disclose omission of pointers from either LO1 or LO2.

(Remarks, pg. 7)

*Examiner respectfully responds:*

The examiner respectfully disagrees and notes that figure 4 clearly does show the omission of pointers LO1 or LO2. As clearly shown in figure 4, the prior art discloses the use of offsets for the navigation of the disc and for the finding of volume descriptors. Thus, contrary to the applicant's suggestion, there is no need for pointers within any of the Lead out area as shown in figure 4 (e.g. Schylander, fig. 4: "LO1", "LO2", "LSN=SZ", "LSN=offs", "LSN=offs+16", "LSN=offs+SZ"; 6: 67 – 7:21, 53 – 66; see also fig. 5, 7, 14; 8:7-34; 10:13-11:9; 13:12-40).



*Applicant argues or asserts essentially that:*

To the contrary, Schylander subsequently discloses (column 15 lines 37 - 40) that such a pointer is required: ...

*Examiner respectfully responds:*

In response, the examiner respectfully notes that the applicant's argument is based upon only one disclosed embodiment of the prior art wherein it is suggested that a pointer may be included within a Lead out area, but applicant's argument appears to ignore the totality of the teachings within the prior art.

The examiner, however, respectfully reminds the applicant that a reference is valid as prior art for all that it teaches, including differing embodiments. As previously noted, the prior art clearly teaches embodiments for recording and successfully navigating a disc wherein pointers within the lead out areas are not required (e.g. Schylander, fig. 4: "LO1", "LO2", "LSN=SZ", "LSN=offs", "LSN=offs+16", "LSN=offs+SZ"; 6: 67 – 7:21, 53 – 66; see also fig. 5, 7, 14; 8:7-34; 10:13-11:9; 13:12-40).

*Applicant argues or asserts essentially that:*

... The Applicants respectfully submit that the cited prior art references, individually as well as in combination, fail to show or suggest at least the following features recited in amended independent claims 1, 11, and 25:

none of the sessions has a pointer in the Q-data of that session's Lead-Out which references a primary volume descriptor of that session;

and information in the Q-data of at least one session's Lead-In for identifying a format of the session is preset irrespective of the format of the at least one session.

(Remarks, pg. 8)

*Examiner respectfully responds:*

The examiner respectfully notes that the applicant's remarks are firstly noted to be unpersuasive, at least, for the reason that they comprise mere allegation in the absence of supporting rationale or evidence. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Secondly, the examiner respectfully notes that applicant's allegations are furthermore unpersuasive, at least, for the reason that they depend upon above unpersuasive arguments (e.g. that the prior art fails to teach Lead out areas without pointers to volume descriptors) or the examiner finds no teaching within the prior art of Q data preset respective of the format of "the at least one session".

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**See Notice of References Cited.**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery Williams/  
Examiner, Art Unit 2437

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2437